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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): 06502.0365

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Signature _____

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Application Number	Filed
10/035,595	12/28/2001

First Named Inventor: Guy L. Steele, Jr.

Art Unit	Examiner
2193	Tan V Mai

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☒ attorney or agent of record. Registration number 56,249
- ☐ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

Nathan A. Sloan
Signature

Nathan A. Sloan
Typed or printed name

202.408.4312
Telephone number

9/30/05
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 2193
PATENT
Customer No. 22,852
Attorney Docket No. 06502.0365-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Guy L. STEELE, Jr.	)	Group Art Unit: 2193
	)	
Application No.: 10/035,595	)	Examiner: Mai, Tan V.
	)	
Filed: December 28, 2001	)	Confirmation No.: 2867
	)	
For: FLOATING POINT ADDER WITH EMBEDDED STATUS INFORMATION	)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests a pre-appeal brief review of the rejections in the Office Actions mailed on September 22, 2004, and May 31, 2005. This Request is being filed concurrently with a Notice of Appeal, in accordance with the Official Gazette Notice of July 12, 2005.

This Pre-Appeal Brief request for review follows the Examiner's Advisory Action mailed August 24, 2005, which merely states "[t]he Examiner believes the rejections are proper" (Advisory Action at p. 1). None of the points raised by Applicant in the Request for Reconsideration mailed July 29, 2005 (hereafter "*RFR*") have been addressed by the Examiner.

Remarks begin on page 2 of this paper.

REMARKS

Claims 1-40 remain pending, with claims 1-5 and 7-40 being the subject of this Pre-Appeal Brief request for review. In the Final Office Action, the Examiner rejected claims 1-5 and 7-40 under two separate 35 U.S.C. § 103(a) rejections: as unpatentable over U.S. Patent No. 5,995,991 to Huang et al. ("*Huang*"); and as unpatentable over U.S. Patent No. 6,009,511 to Lynch et al. ("*Lynch*").

I. The rejection of claims 1-5 and 7-40 under 35 U.S.C. § 103(a) as being unpatentable over *Huang* is improper

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness with respect to claims 1-5 and 7-40 based on *Huang*. *Huang* does not teach or suggest each and every element of Applicant's claims, and there is no motivation to modify *Huang*.

Claim 1 recites a combination including, for example,

> an analyzer circuit ... to determine a ... status of a ... operand based upon data within the ... operand; and
> a results circuit ... configured to assert ... a resulting status embedded within the resulting floating point operand

(emphasis added). The Examiner appears to assert that *Huang's* register 116 (Fig. 4) constitutes the claimed "operand." This is clearly wrong.

Huang specifically distinguishes between a register and an operand, stating "each of the **registers** 116 and 118 has an **operand . . . portion** 116-1 and 118-1." (*Huang,* col. 6, line 66- col. 7, line 1). Moreover, "**operands** X and Y [are] stored in **operand portions** 116-1 and 118-1 of **registers** 116 and 118." (*Huang*, col. 7, lines 8-10). Even assuming that tag values x_tag and y_tag correspond to the claimed "data" or "status," (which Applicant does not concede) the Examiner's contention that *Huang's* register 116 containing x_tag 116-2 constitutes the claimed "data within the ... operand" and a "resulting status

embedded within the ... operand" is clearly contradicted by *Huang*. See, e.g., *RFR* at pp. 3-5.

Structures such as those taught by *Huang* were acknowledged in the Background section of Applicant's specification, which states "conditions are typically represented by flags [a form of status] that are stored in the floating point status register" (paragraph 026). Claim 1 specifically distinguishes over such structures, calling for "data within the ... operand" and a "resulting status embedded within the ... operand." See, e.g., Fig. 2 and paragraph 045 of Applicant's specification.

Accordingly, the Examiner's position that *Huang's* register 116 constitutes an "operand," as recited in the claims, is a clear error. The separate operand 116-1 and separate tag value 116-2 of *Huang* do not constitute a teaching or suggestion of "data within the ... operand" or a "resulting status embedded within the ... operand," as recited by independent claims 1, 15, and 28 and required by dependent claims 2-5, 7-14, 16-27, and 29-40. Since *Huang* fails to teach or suggest each and every element of the claims, no *prima facie* case of obviousness has been established.

Moreover, the Examiner has neither indicated how *Huang* could be modified nor provided any motivation to modify *Huang* to achieve the claimed combination (see *RFR* at pp. 7-8 and Office Action mailed September 22, 2004 at pp. 3-4). Therefore, no *prima facie* case of obviousness has been established for independent claims 1, 15, and 28. Similar arguments apply to dependent claims 2-5, 7-14, 16-27, and 29-40 (see *RFR* at pp. 8-9 and Office Action mailed September 22, 2004 at pp. 4-5).

Therefore, the rejection of claims 1-5 and 7-40 under 35 U.S.C. § 103(a) based on *Huang* is improper. Applicant requests the board of examiners to allow these claims.

II. The rejection of claims 1-5 and 7-40 under 35 U.S.C. § 103(a) as being unpatentable over *Lynch* is improper.

The Examiner's rejection contains clear errors and omits essential elements necessary to establish a *prima facie* case of obviousness of Applicant's claims 1-5 and 7-40 based on *Lynch*. *Lynch* does not teach or suggest

> an analyzer circuit ... to determine a ... status of a ... operand based upon data within the ... operand; and
> a results circuit ... configured to assert ... a resulting status embedded within the resulting floating point operand

(emphasis added) as recited by claim 1.

The rejection does not make clear what portion(s) of *Lynch* allegedly teaches the claimed "status." However, even assuming that *Lynch's* tag value constitutes "status," (which Applicant does not concede) the tag value of *Lynch* is not "embedded within the resulting ... operand," as recited by claim 1.

The Examiner appears to assert that *Lynch's* element 84 (Fig. 4) constitutes an "operand" which contains tag field 89 (alleged status). See Office Action mailed September 22, 2004 at p. 5. This is incorrect. *Lynch* specifically states that element 84 is a register stack, not an operand, and that register stack 84 contains a separate Reg Field 87 for storing an operand and a separate Tag Field 89 for storing a tag (alleged status). See *RFR* at pp. 10-12. Fig. 4 of *Lynch* clearly illustrates that Tag Field 89 (alleged status) and Reg Field 87 (operand) are separate from each other and stored within register stack 84. This does not constitute a teaching or suggestion of "data within the ... operand" or "a resulting status embedded within the resulting ... operand," as recited by independent claims 1, 15, and 28 and required by dependent claims 2-5, 7-14, 16-27, and 29-40. See *RFR* at pp. 10-12. Because *Lynch* does not teach each and every element recited in the claims, no *prima facie* case of obviousness has been established.

Moreover, the Examiner has neither indicated how *Lynch* could be modified nor provided any motivation to modify *Lynch* to achieve the claimed combination (*see RFR* at p. 13; *see* Office Action mailed September 22, 2004 at pp. 5-6). Therefore, no *prima facie* case of obviousness has been established for independent claims 1, 15, and 28. Similar arguments apply to dependent claims 2-5, 7-14, 16-27, and 29-40 (*see RFR* at p. 14; and *see* Office Action mailed September 22 at pp. 6-7).

Accordingly, the rejection of claims 1-5 and 7-40 under 35 U.S.C. § 103(a) based on *Lynch* is improper. Applicant requests the board of examiners to allow these claims.

In view of the foregoing, claims 1-40 are in condition for allowance. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: September 30, 2005

By: Nathan A. Sloan
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